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09/893,748	06/29/2001	Gary B. Robinson	16113-1342RE2	3348
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EXAMINER CARLSON, JEFFREY D				
ART UNIT 3622		PAPER NUMBER		
NOTIFICATION DATE 03/05/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

### Office Action Summary

**Application No.**

09/893,748

**Applicant(s)**

ROBINSON, GARY B.

**Examiner**

Jeffrey D. Carlson

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 42-47, 51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 and 48-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SEI/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 11/7/01, 4/9/03

### **DETAILED ACTION**

This action is responsive to the paper(s) filed 11/9/2009.

#### ***Election/Restrictions***

1. Applicant's election with traverse of groups 1 and 2 in the reply filed on 11/9/2009 is acknowledged. The traversal is on the ground(s) that groups 1 and 2 both contain original patent claims [37 CFR 1.176(b), MPEP 1450]. Applicant suggests that both groups 1 and 2 be examined. This is persuasive. Examiner shall examine the claims of groups 1 and 2 (claims 1-41, 48-50).
2. Claims 42-47, 51-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/9/2009.

#### ***Oath/Declaration***

3. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The error is not present in any of the elected groups 1 and 2 (claims 1-41, 48-50). The error appears to be corrected in non-elected and withdrawn claim 45 only.

#### ***35 USC 251 Rejections***

4. Claims 1-41, 48-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. Claims 26-38, 41, 48-50 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

6. Parent application 08/774,180 had one office action (6/15/1998) in which art rejections were made. In that action the examiner rejected all claims except for dependant 6, 14, 20, 29 having allowable subject matter. 6, 14, 20 represents the feature to show ads for a training period and determine whether the proportion of those

in the community that have chosen the ad is a high proportion or a low proportion. 29 represents the feature that the user can reject the displayed ad and it will be replaced with a second ad determined ad. All rejected claims were canceled without argument. These allowable dependant claims were re-written to include all independent and intervening claims and subsequently all claims were allowed in the next action. Therefore the subject matter in 6, 14, 20, 29 and the presence of the limitation in the independent claims (determine ads to display based on collaborative filtering for a subject's community) were the basis for allowability and form the basis for recapture scrutiny. These claims were rewritten as 30, 37, 46, 52 which were renumbered to 1, 8, 17, 23 respectively at allowance. Claims 26-52 of this reissue have been newly presented in this reissue application (along with copies of the patented claims 1-25). Claims 39 and 40 closely track the parent allowed claims are not believed to represent recapture. While claim 49 includes a similar user-rejection-and-ad-replacement feature, none of claims 48-50 include the critical features of the user's community and collaborative filtering. Therefore claims 26-38, 41, 48-50 represent impermissible recapture.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-16, 26-41, 48-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Examiner recommends including language that specifies a programmed computer is responsible for carrying out the method steps (i.e. not merely a nominal recitation of a computer accepting input or performing output, but rather a computer performing the essential calculations, determinations, algorithms, etc.).
- "[T]he recitation of a computer apparatus in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed, in essence, to the method performed by any means. As such we fail to find that this recitation alone requires the claimed method to include a particular machine such that the method qualifies as a "process" under section 101. We will not

allow such a nominal recitation in the preamble to convert an otherwise ineligible claim into an eligible one." Ex Parte Langemyr, BPAI No. 2008-1495 (28 May 2008).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

8. Claims 26-38, 41, 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, B., An Open Architecture for Collaborative Filtering,  
<ftp://ftp.cs.umn.edu/users/bmiller/prop.ps>, Univ Of Minn., Oct. 26, 1995, pp. 1-18, in view of Herz, U.S. Patent No. 5,754,938.

Miller teaches the invention substantially as claimed by disclosing a method for selectively displaying advertisements to a subject comprising:

- a. Tracking the activities of the subject in the interactive medium (pp. 7-8 "privacy")
- b. Deriving information from the activities of the subject identified in the tracking step (p8 correlation program);
- c. Determining a community of the subject using all or a portion of the information (p. 12 clusters);

d. Determining an object to present to the subject based on the subject's community (p8 prediction).

Miller does not teach a method wherein the object presented to the subject is an advertisement. Herz on the other hand teaches a method wherein the object presented to the subject is an advertisement (Col. 30 lines 39-43 targeted advertisement; Col. 60 line 59 to Col. 61 line 17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Herz with the teachings of Bradley to select advertisements to present to a subject using the collaborative filtering method of Bradley. This combination would have been obvious given Herz's explicit teaching that the technology used to for news filtering, as disclosed in Bradley, is applicable to presenting targeted advertisements (Col. 60 lines 59-62).

Hertz discloses a method wherein the information derived from the activities of the subject comprises information corresponding to at least one of:

- a. An identity of one or more sites the subject has visited (Col. 17 lines 15-65 pages viewed);
- b. A frequency with which the subject visits each of the one or more sites (Col. 68 lines 52-56);
- c. A nature of the information content at the visited sites 10 line 55 to Col. line 5);
- d. An identity of items purchased by the subject (Col. 17 lines 15-65);
- e. A price of any items purchased by the subject (Col. 17 lines 15-65);
- f. Ratings supplied by the subject (Col. 17 lines 15 to Col. 18 line 12 user's manual



adjustment of passive feedback score);

g. A selection of advertisements the subject has chosen to view further information about (Col. 17 lines 15-65 with actual purchase as equivalent);

h. A selection of advertisements in which the subject has indicated disinterest (Col. 17 lines 15-65 user indicates "active distaste").

Miller discloses a method further comprising the step of recording said information in a database (Fig. 2; p. 8 DBMS).

Miller discloses a method wherein the step of recording such information in a database uses at least a portion of a computer program being executed by a processor which the subject used to visit the sites (p. 7 xrn client).

Miller does not explicitly teach a method wherein the at least a portion of a computer program being executed by the processor which the subject used to visit the sites is selected from at least one of the following: an in-line application with the ability to write directly to the subject's computer, a screensaver working in conjunction with a browser, and software incorporated in a browser. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that Miller implicitly discloses this limitation. Although Miller only discusses a method for the collaborative filtering of news articles, Miller does explicitly suggest applying its techniques to additional Internet resource types such as Web pages (p. 16). Given this suggestion, a person of ordinary skill in the art at the time of the invention would have recognized that the program used to "visit the sites," in the case of a method for collaboratively filtering Web pages, would be a Web browser on the subject's computer instead of the news reader client

described in Miller. Official notice is hereby taken of the fact that the software mechanisms listed in the claim were all well known in the art at the time of the invention and were the only options for implementing the method suggested by Miller. Given Miller's teaching of the function and the small set of options for implementing a solution, it would have been obvious to one of ordinary skill in the art at the time of the invention that Miller implicitly discloses the invention of claim 13.

Herz teaches a method wherein the step of determining which advertisements to show the subject based on the subject's community includes the steps of associating a demographic profile with the community and with specific advertisements (Col. 20 lines 10-39). It would have been obvious to combine the teachings of Herz with the teachings of Miller to determine which advertisement to show a user based on demographic profiles because of Herz's explicit teaching that demographic information is useful in determining the similarity of users (Col. 20 lines 10-39).

Miller does not explicitly teach a method wherein the step of recording said information in a tracking database is under Common Gateway Interface control. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that Miller implicitly discloses this limitation. Given Miller's explicit teaching to apply its techniques to additional Internet resource types such as Web pages (p. 16), it would have been obvious to one of ordinary skill in the art at the time of the invention that the subject's Web browser would have to communicate with the tracking database of the server. Official notice is hereby taken of the fact that it is well known in the art to have a Web server communicate with a database application using CGI. It would have

been obvious to one of ordinary skill in the art at the time the invention was made to have a Web server forward messages from the subject's Web browser to the tracking database using the CGI protocol. This combination would have been obvious because it minimizes the amount of custom software that would have to be written, since CGI would pass commands to the tracking database using the existing interface.

Herz teaches a method further comprising the step of filtering the information said deriving step to provide filtered information (Col. 17 line 15 to Col. 18 line 12 where the user activities are filtered to provide a general indication of relevance). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Herz with the teachings of Miller to filter the user information to automatically derive a passive feedback score indicating the relevance, or level of user interest, in the advertisement. This combination would have been obvious because automatically deriving a passive feedback score minimizes the amount of effort the subject must expend in order to indicate a level of relevance for an object.

Miller discloses a method further comprising the step of grouping the subject into a cluster formed of other subjects with similar communities (p. 12).

Miller discloses a system wherein the means for determining which advertisements to show the subject based on characteristics of the subjects community is embodied in software being executed by a processing system used by the subject (Fig. 2; p. 8 prediction, where the Better Bit Bureau server is a processing system used by the subject).

Herz teaches a computer program product wherein the product further comprises computer readable program code means for recording the information in a tracking database stored locally at the guest's remote location (Col. 34 lines 36-43).

Herz teaches a computer program product further comprising computer program code means for displaying an advertisement chosen by the computer program code means for determining (Col. 6 1 lines 1-17).

Herz teaches a computer program product wherein a demographic profile is created for the guest based upon the information derived from the activities of the guest (Col. 61 lines 1-17).

Herz teaches a computer readable program code means for displaying displays the advertisements in a window of a display at the guest's remote location (Col. 61 lines 1-17).

Official notice is taken of the fact that advertisements on Web pages that are linked to an advertiser's site are well known in the art.

***Allowable Subject Matter***

Claims 1-25, 39, 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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